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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,158	12/05/2001	Wu-Bo Li	0942.4750003	3737

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EXAMINER

AKHAVAN, RAMIN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/002,158

Applicant(s)

LI ET AL.

Examiner

Ray Akhavan

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: 48.Claim(s) rejected: 28-47.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

PRIMARY EXAMINER

Continuation of 3.

Applicant's reply has overcome the following rejection(s): With regard to claim rejections under 35 U.S.C. § 103 using Radding in view of Florkiewicz et al. U.S. Patent No. 5,989,867 ("Florkiewicz") or Knappe et al U.S. Patent No. 6,028,058 ("Knappe"), applicant argues that Florkiewicz and Knappe are not prior art because of applicant's benefit of a prior application filed on August 10, 1993. Applicant is correct, since the effective priority dates for the two references are September 22, 1997 and September 23, 1996 respectively. However, the only claim affected is claim 48, which embodies an element not taught by Radding (i.e. probe has a degenerate sequence). In light of this change claim 48 would be allowable but for its dependence from claim 28..

Continuation of 5.

The amendment filed 08/25/2003 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: the proposed amendments introduce new issues that would require further consideration and/or search. It is noted that applicant's remarks are directed towards the claims pending prior to the Final Rejection (i.e. claims 28-48). Because the amendment is not being entered, applicant's arguments relying on such entry are moot, thus will not be addressed.

In comparing the as-filed claims with the currently presented claims, the new issues presented are recited in claim 49, from which all other currently presented claims depend. For example the preamble is changed (compared to as-filed claim 28) to recite, "[O]ne or more desired circular target nucleic acid molecules". Furthermore, the first step introduces the new issue, "obtaining a sample comprising one or more single-stranded desired circular target nucleic acid molecules." Clearly the scope of this claim is distinctly different from the as-filed comparable claim (claim 28). In addition where as-filed claims recite, "target nucleic acid molecule" the currently presented claims recite "one or more of said desired circular nucleic acid molecules." Again, this introduces a new issue that will require additional consideration and/or search.

With regard to as-filed claims, Applicant's arguments are addressed below. Applicant argues that rejection under 35 U.S.C. § 102(b) using Tagle et al., Nature, 361:751-753 (1993) ("Tagle") is improper because Tagle appeared less than one year before an application upon which applicant relies for priority. The Application Data Sheet did fully satisfy the requirement of 37 C.F.R. § 1.78 for specific reference to previously filed applications, thus applicant is correct that Tagle would not apply under §102(b). Presumably applicant is aware that Tagle can be applied under 35 U.S.C. §102(a), as the priority date relied upon is August 10, 1993 while Tagle appeared February 25, 1993. However, the grounds of rejection are the same. In addition, the remainder of applicant's argument viz., Tagle, has to do with after final amendments, which are not being entered, thus the argument will not be considered. The new issue presented is that the method comprises obtaining a sample comprising one or more single-stranded circular target nucleic acid molecule and hybridizing said target with haptenylated probe.

Conclusion:

Amendment after final is not entered. Applicant's claim for priority was proper, thus claim 48 is allowable but for its dependence on a rejected claim.

Any inquiry concerning this communication should be directed to Ray Akhavan at (703) 305-4454. The examiner can normally be reached on Monday-Friday from 9:00-5:30. If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Dr. Remy Yucel can be reached at (703) 305-1998. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1123.